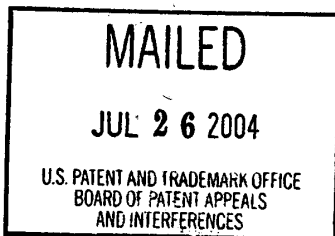The opinion in support of the decision being entered
today was not written for publication and
is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte GORDON R. MEYER, ALBERT R. HOWARD JR.,
KEVIN KNABE and RICHARD B. HOIBERG

_____

Appeal No. 2004-1534[1]
Application No. 09/074,544

_____

ON BRIEF

_____

Before THOMAS, HAIRSTON, and BARRY, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

This application has only recently been returned to us for

decision on the appeal of claims 1 through 61 as noted at the

_____

[1] For administrative processing purposes, the prior appeal number
of 2002-0634 was changed to 2004-1534. This appeal was only recently
received by the panel for decision.

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first page of our remand to the examiner, paper no. 21, mailed on October 29, 2003, which we hereby incorporate by reference.

As explained at pages 2 and 3 of this remand, appellants withdrew the appeal as to claims 1 and 24 in the principal brief on appeal. As indicated at pages 1 and 2 of the supplemental reply brief, appellants also withdrew the appeal as to independent claim 41. As a result of appellants' withdrawal of the appeal as to claims 1, 24 and 41, the appeal as to them is dismissed. Thus, this appeal relates to claims 2 through 23, 25 through 40 and 42 through 61.

Claims 6 through 15, 29 through 38 and 46 through 59 stand rejected under 35 U.S.C. § 102(e) as being anticipated by DeRose as indicated at page 2 of this remand. Correspondingly, claims 2 through 5, 16 through 23, 25 through 28, 39, 40, 42 through 45, 60 and 61 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon DeRose in view of Walls. Because of the compelling teachings in Walls as to indexing and scanning that buttress those in DeRose, the examiner's positions could have been strengthen as to all claims on appeal with a rejection of all of them under 35 U.S.C. § 103.

We incorporate by reference herein the earlier-noted remand to the examiner which reproduces representative claims 1 and 2 on

appeal and lists the particular references relied upon by patent number. We sustain the rejection of all claims on appeal for the reasons set forth by the examiner in the supplemental answer, paper number 22 mailed on January 26, 2004. This answer is responsive to all of the arguments presented by appellants in a supplemental appeal brief filed on August 17, 2001 and the reply brief filed on December 26, 2001. This answer addresses all the arguments presented by appellants in the brief and reply brief urging the patentability of each claim, paying particular note to each respective claim argued in the brief and reply brief. We add the following.

We note here again the remarks made by us at the bottom of pages 5 through 7 of the earlier-noted remand to the examiner which details various remarks we made in passing at that time as to the teachings and suggestions of both references relied upon by the examiner. Pages 6 and 7 of this remand detail our reasons of combinability of DeRose and Walls as to the rejection of 35 U.S.C. § 103. To the extent appellants' previous views have indicated and relied upon column 4, lines 34 through 39 as indicating that the references are not combinable within 35 U.S.C. § 103, we consider this position to be misplaced. This portion of DeRose does not indicate to us, and we believe to the

artisan, that plural data "files" are not operated upon within

the overall teachings of this reference, but rather that a lesser

number than all of them is automatically portioned to the extent

necessary for the user's choice when the document is rather

large. As explained in the paragraph bridging columns 4 and 5 of

the reference, the first representation of the data stored is of

a hierarchy of all elements or files in an electronic document

and stores a second representation of the hierarchy of only

significant elements thereof. See figures 17 and 18. The

advantage of DeRose is that in response to a request for a

portion of the document, the computer system may automatically

select a portion defined by significant elements in the second

representation, less than the first.

We indicated at page 7 of our remand that we considered the

combination of claims 1-2 to correspond very closely to the

subject matter of independent claim 6. By implication, this

relationship may be extended to claims 18, 24-25, claim 29,

claims 41-42, claims 46 and 57, all of which are independent

claims. All of these independent claims (except claim 18)in some

form recite a feature of indexing files to determine a first type

of file and scanning the respective files for an HTML data-tag or

a generic type of tag which is to be added to a table of

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contents. Claim 57 recites the indexing function as a scanning operation and this claim also recites the scanning operation to be an analyzing function.

Our previous views as to DeRose in the remand indicated that we considered that the indexing function that was specifically taught in DeRose to be more generic yet described in detail in Walls. The remarks by appellants as to Walls at the bottom of page 6 of the principal brief on appeal indicates that they realize that this reference teaches an updating and indexing operation on a continuous basis. The examiner has made reference to the discussion of figure 3 at column 13 as to this feature which specifies that updating will occur on a regular basis such as to automatically scan at off-peak hours. The figures beginning with figure 8 show the last generation of the information index based on hours, minutes and date. It is thus recognized that Walls clearly teaches the additional scanning operation to <u>add</u> files to a table of contents automatically in an up to date manner.

The supplemental answer has made reference to the teachings at column 5, line 54 through column 6, line 15 and column 21, line 40 through column 22, line 7 to indicate that previously static or non updated information files at the bottom of column 1

of DeRose would be modified or otherwise edited in a dynamic manner to the extent recited in the claims on appeal. These teachings make clear that there is a dynamic generation of the table of contents when the document is modified or edited for any purpose. Thus, even DeRose teaches the basic content of scanning files to add data to a previously existing table of contents according to his teachings. Even figures 3 through 8 and certainly figures 3, 5, 17 and 18 indicate an indexing-type function in a hierarchal manner; each of the levels shown in these figures may be considered file types of a first type and each other level may be considered file types of a second or third, etc. type. For example, specific chapters, sections, etc. are specifically illustrated. DeRose contemplates the updating, for example, of a chapter heading when this has been edited. Figure 8 and its discussion relates to full text hierarchal indexing of a document as that shown in meta tag/mark up tag format in figure 4.

To the extent recited in representative independent claim 6 on appeal, the template may be considered in DeRose as also the so-called style sheets which perform a mapping table operation according to the discussion beginning at column 12 through several succeeding columns in addition to the examiner's views.

The manner in which HTML mata-tags are set forth in any given

document have been established according to the HTML protocol

associated with this language and are considered to be themselves

a form of template. It is believed that the discussion in these

noted columns set forth examples of template like operations.

Because the discussion in the second paragraph at the Background

at column 1 of DeRose indicates that a Standard General Mark Up

Language SGML, an industry standard, is used quite extensively in

databases accessible through the Internet, DeRose specifically

teaches the opportunity to translate such a mark up language to

Hypertext Markup Language (HTML). The discussion in the second

paragraph at column 19 makes clear that the resulting table of

contents document includes HTML language tags. The overall

structure of DeRose permits the translation of SGML to HTML upon

which the system operates. A new or revised/edited HTML-based

Table of Contents is then formed (figure 16) as discussed

beginning at column 17, line 60, and shown in figures 17 and 18.

We do not agree therefore with appellants' urgings at pages

2 and 3 of the supplemental reply brief that the examiner's

reasoning is flawed to the extent that the examiner considers in

the answer his characterization of self contained objects

(Supplemental Answer, pg. 11) as comprising files to the extent

recited in the claims on appeal. The claims that do recite files

do not recite any definition of them, such as claim 6.

Appellants' Background discussion at pages 1 and 2 of the

specification as filed does not offer any distinguishable

characteristics of the prior art to define files over any of

their type of characterization of the information known to relate

to HTML links. Moreover, appellants' specification at the bottom

of page 2 in the Summary of the invention indicates that the

information gathered by a scanning operation is merged with

predetermined HTML template files that control formatting and

presentation of the information. Thus, not only is the template

feature of the claims on appeal apparently known in the art, the

characterization of HTML mata-tags appears to be considered by

the art as a kind of file. Both references clearly teach these

general concepts of designating identifiable portions of HTML

documents as files.

In view of our earlier remarks, we are unpersuaded by

appellants' arguments at page 3 of the supplemental reply brief

relating to the scanning and indexing functions of representative

claim 6. As indicated earlier, the fact that DeRose operates on

SGML documents as asserted here is an incomplete view of DeRose

to the artisan. Appellants appear to answer their own question

because they recognize that DeRose down-converts the SGML

document into an HTML document. It is clear to the artisan in

studying DeRose that if a document is going to be operated upon

in a dynamic manner to achieve a dynamically generated table of

contents, if it were not in SGML mark up language, the functional

operation of DeRose's device would proceed along the lines of an

HTML document and indexed/scanned accordingly as discussed

earlier. Again, it is emphasized that the subject matter of

independent claims 6, 29, 46 and 57 rejected under 35 U.S.C.

§ 102 correspond in basic features to each other.

Appellants' urging at page 4 of the supplemental reply brief

that the examiner has mischaracterized appellants' previous

arguments is noted. The real issue here appears to be what is a

folder. Appellants' specification illustrates a help folder in

figure 2 which has a hierarchal representation of various books

and chapters etc.. This figure shows a hierarchal representation

of subject matter which is equally found to be illustrated in the

corresponding hierarchal structure in DeRose's figures 3, 5, 17

and 18. Any one of these figures in DeRose may therefore be

considered a "help folder" for purposes of understanding the

meaningfulness of the word "folder" in some of the claims on

appeal and understanding the dimensions of a so-called "help

system" in some claims on appeal. Since this hierarchy is the same, the document of DeRose is a folder in the preambles of some claims.

To follow on with this analysis, the whole concept of a table of contents in DeRose appears to us to correspond to the information index, the showing of which began in figure 7 of Walls. For example, in figure 8, air travel is subdivided into airlines, which is further subdivided into various airlines listed alphabetically, which clearly corresponds in concept to a table of contents representation. Indeed, this and the succeeding findings may be considered by the artisan as comprising a table of contents even though it is shown as an "Information Index" in these figures. Clearly, the teachings of DeRose and Walls overlap significantly.

In view of these remarks, we are also unpersuaded that the examiner has improperly used concepts of a table of contents in an index interchangeably as asserted at page 5 of the supplemental reply brief. In addition to our earlier remarks, we note that a table of contents is like an index in the sense that both illustrate relative location of their parts or portions making them up. Figure 9 of DeRose, for example, in element 162 shown there as a table of contents also shows a hierarchal

numbered ordered index of files. An alphabetical approach

corresponding to this is shown according to the various

information indexes illustrated at the beginning of figure 8 of

Walls.

We are similarly unpersuaded by appellants' remarks at the

bottom of page 4 of the supplemental reply brief that the

examiner mischaracterizes appellants' claims. Appellants assert

that the supplemental examiner's answer as to independent claims

6, 29 and 46 states that DeRose discloses dynamically generating

a table of contents using a template in response to activation.

Appellants argue that these features are not recited in these

claims. However, our review of independent claim 6 indicates the

concept of dynamically generating a table of contents is in the

preamble of this claim, the concept of in response to activation

is also in the preamble of claim 6 and the use of a template is

in the body of claim 6.

In closing, we note again that the examiner has identified

and provided corresponding teachings and locations in DeRose and

Walls as to those particularly argued claims in the principal

brief on appeal. The supplemental reply brief does not provide

any criticisms of the examiner's positions as to most of these

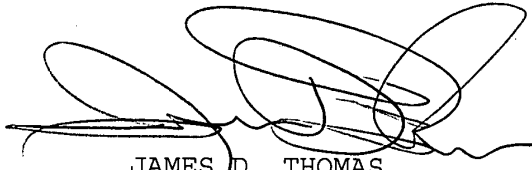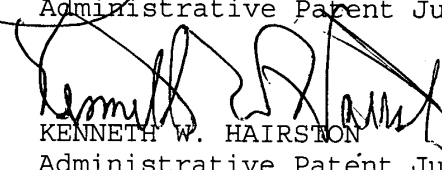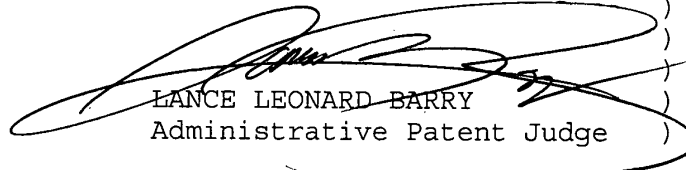claims. Appellants' remarks at page 5 of the principal brief on

appeal considers all of independent claims 1-2, 18, 24-25 and
41-42 to fall together as a single group. The succeeding remarks
in the body of this brief are consistent with this grouping. The
paragraph bridging pages 1 and 2 of the supplemental brief urges
the patentability of claim 18 based upon the feature activating a
help system and the determination steps. Appellants do not
present any arguments here, however, to distinguish over the
views taken by the examiner as to this claim at page 7 of the
supplemental answer, and in the examiner's corresponding
discussion as to corresponding features in depending claim 60 at
pages 8 and 9 of this answer as well. It is implicit of DeRose
alone that if the table of contents according to his teachings
does not exist for any document that has been downloaded from a
web site, one would be constructed according to the two-prong
approach of DeRose. We have already indicated that an up to date
capability exists within this reference which is refined
according to the teachings of Walls to the extent the rejection
of claims 18 and 60 are based upon 35 U.S.C. § 103 and the
combination of teachings and suggestions of both references.

In view of the foregoing, the decisions of the examiner
rejecting selected claims on appeal under 35 U.S.C. § 102 and
35 U.S.C. § 103 is affirmed.

Appeal No. 2004-1534
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No time period for taking any subsequent action in

connection with this appeal may be extended under 37 CFR

§ 1.136(a).

<u>AFFIRMED</u>

JAMES D. THOMAS
Administrative Patent Judge   )
)
)
) BOARD OF PATENT
KENNETH W. HAIRSTON   )   APPEALS AND
Administrative Patent Judge   )   INTERFERENCES
)
)
)
LANCE LEONARD BARRY   )
Administrative Patent Judge   )

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